

Docket No. 200209168-1

Remarks

This communication is responsive to the Restriction Requirement of January 10, 2007. Applicant makes elections, with traverse, as set forth below. Reexamination and reconsideration of claims 1-36 and 38-54 is respectfully requested.

Summary of The Restriction

Restriction to one of the following species was required under 35 U.S.C. 121, as described in the Office Action:

Species I: hereby drawn to a first fire line, a second fire line, a first address generator, a second address generator, a first drop generator, and a second drop generator;

Species II: hereby drawn to a first fire line, a second fire line, a first address generator, a second address generator, and fluid ejectors;

Species III: hereby drawn to a first address generator, a second address generator, first resistors, second resistors, a first address line, a second address line, the first resistors being located in a first section and the second resistors being located in a second section of the fluid ejection device;

Species IV: hereby drawn to a first fire line, a first address generator, a second address generator, a first drop generator, a second drop generator, data lines, and a first fluid feed source;

Species V: hereby drawn to a first fire line, a first address generator, a first drop generator, a second drop generator, data lines, and a fluid feed source;

Species VI: hereby drawn to a first fire line, a first address generator, a first drop generator, and a latch.

Claims 35, 36 and 38 were indicated to be generic to species I and species III.

Docket No. 200209168-1

Election

Applicant elects, with traverse, Species I. A listing of claims readable on Species I are claims 1-36 and 38-42.

Applicant traverses the restriction as follows.

MPEP 809.02(a) "Election of Species Required" cites MPEP § 808.01(a) for determining when a restriction between species is appropriate. MPEP 808.01 states:

MPEP 808.01 Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. [Emphasis added]

For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed. (MPEP 808.01)

The Office Action articulates only a mere conclusion for requiring an election of a single species as:

"The species are independent or distinct because each species requires a different and extensive search." (Office Action, page 3, lines 6-7)

Applicant respectfully submits that the statement of "requires a different and extensive search" is a mere conclusion and is not a valid reason under MPEP 808.01 that supports a conclusion. The conclusion also does not prove that the identified species are independent and distinct. For proving distinct claims in a restriction, MPEP 806.05(e) states, "The burden is on the examiner to provide reasonable examples that recite material differences." Since no reasonable examples have been provided, a prima facie case for the

Docket No. 200209168-1

propriety of the restriction requirement has not been presented. Thus, the restriction should be withdrawn.

Full Search Already Performed

Applicant respectfully notes that the first Office Action dated 4-20-2006 included a full and extensive prior art search for all pending claims. Furthermore, a substantive examination on the merits was provided. In Applicant's response, no new claims were added. Therefore, if a "different and extensive search" was not needed then, how can this be a reason for restriction at this time for the same claims? The fact that the Examiner already performed a search contradicts and disproves the Examiner's own conclusion. Thus, the restriction is not justified and should be withdrawn.

Restriction Is Not Proper Since Species Are Not Mutually Exclusive MPEP 806.04(f)

As an additional reason for traversal, a comparison of the limitations and scope of each independent claim shows that the claims share many of the same limitations. Thus, the independent claims overlap in scope and therefore, the species are not mutually exclusive. Accordingly, restriction between claims limited to species should not be required based on MPEP 806.04(f), which states:

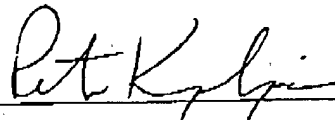
MPEP 806.04(f) Restriction Between Mutually Exclusive Species

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope. [Emphasis Added]

Docket No. 200209168-1

In the present application, the identified species are not mutually exclusive and the claims overlap in scope since they recite similar limitations disclosed for the multiple species. Therefore in view of MPEP 806.04(f), the restriction is improper and should be withdrawn.

Respectfully submitted,



PETER KRAGULJAC (Reg. No. 38,520)
(216) 348-5843
McDonald Hopkins Co., LPA
600 Superior Avenue, E.
Suite 2100
Cleveland, OH 44114